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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,010	11/17/2003	David S. Benco	LUTZ 2 00251	3279
48116	7590	06/27/2006	EXAMINER WIN, AUNG T	
FAY SHARPE/LUCENT 1100 SUPERIOR AVE SEVENTH FLOOR CLEVELAND, OH 44114			ART UNIT 2617	PAPER NUMBER

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/715,010	BENCO ET AL.
	<b>Examiner</b> Aung T. Win	<b>Art Unit</b> 2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 April 2006.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed 04/05/2006 have been fully considered but they are not persuasive.

Applicants argue that Qua expressly teaches away from the teaching of Bartfeld. To support this argument, applicants rely on the "background of the invention" section of Qua, which states, as disclosed by Applicants, "such communication techniques are ineffective because, in order to gain full advantage of the portable/wireless devices, they are being used in non-traditional environments outside the home or office." On the other hand, applicants added, Bartfeld can only be used where the user has subscribed to a television service.

Examiner respectfully disagrees with Applicants' assertions by reminding Applicants that the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). In addition, nowhere in the Qua's reference there is any direct or indirect criticism of the solution claimed in the Bartfeld reference. Moreover, Qua's invention is to provide the method of recording specific conversion and further to store in a network storage device in which the system is implemented to interface with **other communications systems** including voice servers [See Summary]. Therefore, Examiner asserts that there is no teaching away present in the rejection as written. And, the rejection, as written, stands.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Qua discloses a system recording specific conversation based on user command and further storing the recorded conversation in a network storage device. Bartfeld also teaches a system recording the phone conversation based on the user command further storing the recorded conversation in a network storage device i.e., voice mail server. Qua also teaches that the system provides an interface with other communications systems including voice servers. Therefore, the references are the analogous arts and the rejection, as written, stands.

Applicant also argues that Qua does not expressly disclose that the system monitors the reverse link and detects the signals transmitted on the reverse link. Examiner disagrees. Qua teaches that the system records and stores specific conversation in a network storage device based on the detected the user record commands. Therefore, it is obvious to one of ordinary skill in the art at the time of invention of made that Qua's method teaches claimed monitoring step because the

system is monitoring the reverse link by determining whether the user record command signal is detected from the user i.e., reverse link.

Applicant also argues that Qua does not teach the opening of a connection between the mobile station and a voice mailbox messaging system based on the first code. Modified system clearly teaches such limitation in order to store the recorded conversion in the voicemail server.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., voice **mailbox** messaging system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Cited limitation in rejected claim is voice messaging system. Not all the voice messaging system is voice **mailbox** messaging system. At the time of invention of made, it is obvious to one of ordinary skill in the art the voice messaging system is the system to store and retrieve recorded or stored audio messages. The examiner is fully aware of what the claims do not call for, as well as what they do require. During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023

(Fed. Cir. 1997). See MPEP § 2111 - § 2116.01 for case law pertinent to claim analysis.

Applicant also contends that modified system does not teach validating the mobile station i.e., validating the mobile station by **determining if the user is a subscriber**. Such determination limitation is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). At the time of invention of made, it is also obvious to one of ordinary skill in the art that Qua's system provide services to users with mobile station registered with the network and therefore Qua's method comprises claimed validating step to determine if the user is authorized access to the network.

Applicant also argues that modified system does not disclose voice memo control module, a first or second communication path or a voice handler. At the time of invention of made, it is obvious to one of ordinary skill in the art that modified message recording and retrieving system comprises claimed components because such components are implemented and utilized in applications such as retrieving messages.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua et al. (US Patent Number: US006222909B1) in view of Bartfeld et al. (US Publication Number: US 20030086432A1).

Regarding Claim 1, Qua discloses a method for supporting a network-based audio note-taking feature (reads on network-based voice memo feature) [Summary] [Figure 1] for wired and wireless terminal user devices in telecommunication network [Column 2, Line 49- Column 3, Line 7]. Qua's method comprises:

Recording a specific conversation during a conversation between users [Column 1, Line 40-49] [Column 3, Line 22-39] [Column 4, Line 29-39] or retrieving a recorded conversation i.e., retrieving recorded notes during the current call [Column 6, Line 39-44] (Recording or retrieving step reads on maintaining step).

One skilled in the telecommunications art would realize that the voice call in Qua's method have a forward link and reverse link in which reverse link being a link from a mobile station to a base station since the method is operative to the telecommunication network as depicted in Figure 1.

Qua teaches monitoring and detecting control signals (i.e., record signal and terminate signals) generated by mobile stations on reverse links (see reverse link as stated above) (Also See [Column 3, Line 22-26] [Column 5, Line 28-31] [Column 6, Line 59-

Column 7, Line 30] for generating control signals by users for recording audio notes and retrieving recorded audio notes i.e., initiating recording sequence (pressing start button) or terminating recording sequence (pressing stop button) or retrieving recorded audio notes sequence. (Generating a start sequence reads on a first code and generating a stop sequence reads on a second code).

Although Qua's method store the recorded voice data in network based storage 180, Qua fails to teach the opening a connection step between the mobile station and a voice messaging system based on the first code then record to store voice data in a voice mailbox based on the first code. Instead, Qua's method teaches a recording step to store the recorded voice data in Network Storage 180 Storage 180 [Figure 1] [Column 3, Line 59-66] based on a first code and further discloses a distribution step option in which recorded voice data stored in Network to be forwarded to a voice mail server [Step 310, Step 320, Step 322 and Step 324 in Column 5, Line 48-Column 6, Line 4] using voice mail addresses (reads on identification of voice mail boxes) based on a distribution code.

Bartfeld teaches a telephone call management system and method in which a telephone conversation can be recorded in the voice mail server 90 [Figure 1, 2 & 3] [Step 870 in Figure 7] [Column 5, Paragraph 0044] based on record command [Paragraph 0044, Line 9-10]. Bartfeld's system and method also teaches the storing of voice data in other recording devices for extreme flexibility [Column 5, Paragraph 0045, Line 9-13].

Therefore, it would have been obvious to one of ordinary skill in the art to modify the Qua's voice recording and storing method with Bartfeld's method to record a voice data using voice messaging system based on a first code by efficiently removing network storage and utilizing existing voice messaging system to store recorded data. One of ordinary skill in the art would have been motivated to do this to reduce the processing step and to implement cost-effective system by reducing the hardware expenditures.

Claim 6 is an apparatus claim rejected for the same reasons as stated above in Claim 1 rejections because claim means read on corresponding method steps rejected in Claim 1. Modified Qua's system for network-based voice memo would have corresponding means for executing the claims' step recited in Claim 1 rejection.

Claim 11 is rejected for the same reasons as stated above in claim 1 rejection because Claim means substantially read on corresponding method steps rejected in Claim 1. Modified Qua's system has a voice messaging system 170 [Figure 1 of Qua]. One skilled in the telecommunications art would also realize that there would be a switching component implemented and operative to maintain a voice call in the modified Qua's system in order to provide the network-based voice memo feature. Qua clearly teaches the requirements and implementation of switches necessary to perform such network features in the telecommunication network [Qua reference: Column 2, Line 55-60 & Column 3, Line 8-21] [Also see Bartfeld reference: Telephony switch 25 in Figure

1-3 & Column 3, Paragraph 0029, Line 7-20]. Modified Qua's system comprises a control module [See Qua reference: Column 3, Line 8-26] i.e., a controller implemented in note taking mechanism 129 reads on a control module.

Regarding Claims 2, 7 & 12, note taking mechanism 129 verify if the user has enabled a private mode function (reads on validating the mobile station) [See Qua reference: Column 4, Line 60-62].

Regarding Claims 3, 4, 8, 9, 13 & 14, modified Qua's system identification step to identify the stored information in order to retrieve the stored information correctly from stored voice mail addresses i.e., voice mail box [See Qua reference: Column 3, Line 65; Column 5, Line 18-41 & Column 6, Line 33-35]. One skilled in the telecommunication arts also would realize that stored recorded voice data would have been identified and store in a voice mailbox in order to retrieve the targeted message in modified Qua's system. Moreover, Identifying the voice message for storing in a voice mailbox and for retrieving the identified voice message is well known to one of skilled in the telecommunication arts.

Regarding Claims 5, 10 & 15, modified Qua's system would have connected the mobile station and the voice messaging system through the voice memo control module i.e., the controller implemented in note taking mechanism [See the claim 11 rejection]

and a voice handler i.e., the audio recording processors implemented in note taking mechanism in order to record the conversation i.e., voice memo (a first path reads on the communication path from a mobile station to the controller of note taking mechanism for the controller to receive the control signals i.e., first code and second code) and (a second path reads on the communication path between the controller of note taking mechanism and the corresponding processors).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Beith et al.                    US Publication Number:                    US 20030235275A1

Moores et al.                    US Publication Number:                    US 20040132432A1

Silberfenig et al.	US Publication Number:	US20010041590A1
Schuster et al.	US Patent Number:	US006795429B1
Sahasrabudhe	US Publication Number:	US 20030210768A1

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung T. Win whose telephone number is (571) 272-7549. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aung T. Win  
Group Art Unit 2617  
June 14, 2006

  
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PRIMARY EXAMINER

Application/Control Number: 10/715,010  
Art Unit: 2617

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